

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Alain Joseph Jean Garnier Confirmation No. 7212
Serial No. : 10/588,321 Art Unit: 1616
Filed : August 3, 2006 Examiner: Danielle D. Sullivan
For : SYNERGISTIC ANTIFUNGAL DDAC COMPOSITIONS

The Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Appellant files this request for review of the final Office action of July 22, 2010, as modified by the Advisory Actions of October 6, 2010, and December 17, 2010. This request is filed concurrently with a Notice of Appeal, so it is timely. Please note, the Applicants filed a one (1) month extension of time concurrently with the Supplemental Response filed under 37 CFR § 1.116 on November 1, 2010. Accordingly, the Applicants have filed a request herewith for an additional extension of time for two (2) months from November 22, 2010 to January 22, 2011.

I. Final Office Action

The examiner entered a final Office action on July 22, 2010, wherein claims 1, 2, 9,10, 13 and 14 were finally rejected under 35 U.S.C. § 103 (a) as allegedly obvious over US 200310199490 (“the Antoni-Zimmermann publication”). Importantly, the examiner stated at page 6 of the Office action under the heading “Comparative Data:”

The specification provides unexpected results for DDAC in combination with imazalil at the following ratios, 2:1, 1 :5 and 1 :50, however the claims recite the range of 1:100 to 10:1. Therefore, the showing is not commensurate in scope with the claims.

II. Response under 37 CFR § 1.116

Appellant filed a response to the final Office action on September 14, 2010, wherein the claims were amended to recite that the ratio by weight of DDAC and

fungicide ranged from 1:50-2:1, in accordance with the examiner's finding of unexpected results.

III. Advisory Action of October 6, 2010

The examiner indicated in an Advisory Action dated October 6, 2010 (AA1) that the proposed amendment would not be entered as it allegedly raised new issues that would require further search and/or consideration. The examiner did not explain why narrowing the claims in accordance with the indication of "unexpected results" in the final Office action raised new issues.

IV. Examiner Interview

The undersigned spoke with Examiner Sullivan on or about October 26, 2010 to discuss why the amendment had not been entered. In the course of the conversation, the examiner indicated that the proffered claims were not commensurate in scope with the subject matter said to be directed to "unexpected results" in the final Office action since the fungicide component of the claims was not limited to imazalil.

V. Supplemental Response Under 37 CFR § 1.116

In accordance with the interview with Examiner Sullivan, Appellant filed a Supplemental Response under 37 CFR § 1.116 on November 1, 2010, in which the claims were amended to recite the narrowed ratio and that the fungicide is imazalil.

VI. Advisory Action of December 17, 2010

Rather than receive the expected Notice of Allowance, Appellant received a second Advisory Action (AA2) in which the examiner entered the amendment but, for the first time, indicated that, Appellant had to make a side-by-side comparison to the "teachings" of the Antoni-Zimmermann publication because that publication allegedly is directed to "synergistic" mixtures.

VII. Discussion

The examiner's new requirement that Appellant provide the requested side-by-side comparison is procedurally, factually and legally in error.

The examiner procedurally errs because it is improper for her to raise, for the first time in a second Advisory Action, an objection to specification evidence that the examiner has already considered and found persuasive. The new requirement of a

side-by-side comparison with the Antoni-Zimmermann publication is, in essence, a new ground of rejection. If the examiner had made this requirement prior to the final Office action, Appellant would have had a full and fair opportunity to respond. The unfairness of the examiner's action is apparent.

The examiner's new request also is factually and legally erroneous. The pending claims are directed to synergistic antifungal mixtures of imazalil and DDAC having a weight ratio from 1:50 to 2:1. The Antoni-Zimmermann publication describes synergistic biocidal mixtures that comprise (1) a pyrithione and (2) a 2-alkylisothiazolin-3-one as a further biocidal active ingredient (*Id.*, [0014]). The publication makes it clear that it is the pyrithione and 2-alkylisothiazolin-3-one compounds that provide the synergism in that invention (*Id.*, [0042]).

The Antoni-Zimmermann publication goes on to state that the "biocide composition according to the present invention may comprise one or more other biocidal active ingredients which are selected as a function of the specific system to be preserved" (*Id.*, [0054]). The publication then provides a long list of other biocidal active ingredients that can be used *in addition* to the pyrithione and the 2-alkylisothiazolin-3-one including imazalil and DDAC. The publication, however, does not indicate that mixtures of imazalil and DDAC provide synergistic results. Rather, what the publication discloses is that it is mixtures of the pyrithione and the 2-alkylisothiazolin-3-one mixtures that provide synergistic compositions. In other words, the present claims are directed to synergistic mixtures of A and B, whereas the Antoni-Zimmermann publication is directed to synergistic mixtures of C and D, which may also include, out of thousands of additional compounds, A and B. The examiner provides no evidence or persuasive reasoning for the unstated proposition of her new position that because a reference describes synergistic mixtures of C and D one would expect to find synergistic mixtures of A and B.

The newly requested side-by-side comparison with the "teachings of Antoni-Zimmermann" does not make sense as the comparison would be between mixtures of imazalil and DDAC and mixtures of pyrithione and 2-alkylisothiazolin-3-one, i.e., an apple to oranges comparison. There is no direct teaching in the Antoni-Zimmermann publication of using imazalil and DDAC together and certainly no teaching that if one

fortuitously picked those two compounds from the list of thousands of other possible additional compounds described in the reference that one would have any reasonable expectation that those two compounds can result in synergistic mixtures.

As a further point, it is noted that the Antoni-Zimmermann publication only discloses weight ratios for the inventive synergistic mixture of pyrithione and 2-alkylisothiazolin-3-one (*Id.*, [0046]). The publication does not disclose the amount to be used of any of the thousands of possible additional compounds set forth in [0054]-[0094]. Thus, assuming one would pick imazalil and DDAC from the list of additional compounds, there is no teaching in the Antoni-Zimmermann publication as to the amounts or weight ratios these compounds should be used. The examiner does not account for this missing disclosure.

In summary, even if it is considered that the examiner properly raised this issue in the second Advisory Action, it is seen that there is no need for Appellant to provide the requested side-by-side comparison because it would be comparing apples to oranges. Appellant respectfully requests that the pending rejection based upon Antoni-Zimmermann be withdrawn and the case be passed to issue.

Appellant does not believe that any fees are required in connection with the filing of this request. Please charge any fees, which may be required for this submission to Johnson & Johnson Deposit Account 10-0750/PRD2188USPCT/JKM.

Respectfully submitted,

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